

ESTTA Tracking number: **ESTTA425645**Filing date: **08/17/2011**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91200614
Party	Defendant WaveMarket, Inc.
Correspondence Address	ALAN KORN LAW OFFICE OF ALAN KORN 1840 WOOLSEY ST BERKELEY, CA 94703-2453  aakorn@igc.org
Submission	Answer and Counterclaim
Filer's Name	Alan Korn
Filer's e-mail	aakorn@igc.org, korn.alan@gmail.com
Signature	/Alan Korn/
Date	08/17/2011
Attachments	Answer and Counterclaim - Opposition No 91200614.pdf ( 7 pages )(288657 bytes )

## Registration Subject to the filing

Registration No	3716436	Registration date	11/24/2009
Registrant	Thomas J. Long 4 Preserve Drive Nashua, NH 03064 UNITED STATES		

## Goods/Services Subject to the filing

Class 035. First Use: 2008/09/01 First Use In Commerce: 2008/09/01

All goods and services in the class are requested, namely: Consulting services, namely, expert analysis and management consulting in economics in the nature of providing statistical analysis and reporting for commercial business purposes of marketing information and data, namely, household and business populations within a market, modeling purchase demand for products/services, analyzing commuting corridors, drawing patterns and trip generation appeal, examining existing competition, uncovering underserved markets, ranking, scoring and prioritizing the relative quality of a variety of different markets, defining expansion plans, identifying means of entry into the market by analyzing commuting corridors, draw patterns and trip generation appeal, examining existing competition, scoring the convenience standards presently established by the existing competitive set, identifying alternative site locations for businesses, ranking, scoring and prioritizing available locations to identify competitive advantage and isolating those with parity or superiority based upon objective criteria, linking the demographics of the defined market to determine the market's purchase demand for products/services, establishing likely usage to define expected penetration, valuing the potential by uncovering the revenue associated with the location, developing pro forma staffing and expense projections personalized to the location, identifying the operating configuration requirements necessary to meet market and service usage needs, calculating the annual financial impact in the nature of profit and loss surveys and analysis of the new location and producing a cumulative cost recovery schedule over the first five years of operation and calculating profit per square foot

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

THOMAS J. LONG	)	Opposition No. 91200614
	)	
Opposer,	)	Serial No. 85148889
	)	
v.	)	Mark: LOCATION LABS
	)	
WAVEMARKET, INC.	)	
	)	
Applicant.	)	
	)	

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**APPLICANT’S ANSWER TO THE NOTICE OF OPPOSITION AND  
COUNTERCLAIM**

In response to the Notice of Opposition issued by the Board on July 11, 2011, WaveMarket, Inc. (“Applicant”) hereby responds to Thomas J. Long (“Opposer”) as follows:

1. In response to the allegations of paragraph 1 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the allegations therein, and on that basis denies each and every such allegation.

2. In response to the allegations of paragraph 2 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the allegations therein, and on that basis denies each and every such allegation.

3. In response to the allegations of paragraph 3 of the Notice of Opposition, Applicant admits that Exhibit A consists of a copy of the registration for United States Trademark Registration No. 3,716,436 for LOCATIONLAB. Applicant is without

knowledge or information sufficient to form a belief as to all remaining allegations in paragraph 3, and on that basis denies those allegations.

4. In response to the allegations of paragraph 4 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the allegations therein, and on that basis denies each and every such allegation.

5. Applicant admits the allegations in Paragraph 5 of the Notice of Opposition.

6. Applicant admits the allegations in Paragraph 6 of the Notice of Opposition.

7. Applicant incorporates by reference his answer to paragraphs 1 through 6 of the Notice of Opposition.

8. In response to the allegations of paragraph 8 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the allegations therein, and on that basis denies each and every such allegation.

9. Applicant denies the allegations in Paragraph 9 of the Notice of Opposition.

10. Applicant denies the allegations in Paragraph 10 of the Notice of Opposition.

11. Applicant denies the allegations in Paragraph 11 of the Notice of Opposition.

12. Applicant denies the allegations in Paragraph 12 of the Notice of Opposition.

### **AFFIRMATIVE DEFENSES**

In further answer to the Notice of Opposition, Applicant asserts that:

### **FIRST AFFIRMATIVE DEFENSE**

Opposer's Notice of Opposition fails to state a claim upon which relief may be granted, and in particular, fails to state legally sufficient grounds for sustaining the opposition.

### **SECOND AFFIRMATIVE DEFENSE**

The Notice of Opposition is barred in whole or in part by the doctrine of equitable estoppel, laches, waiver and abandonment.

### **THIRD AFFIRMATIVE DEFENSE**

The Notice of Opposition is barred by fraud, mistake and/or the doctrine of unclean hands.

### **FOURTH AFFIRMATIVE DEFENSE**

The Notice of Opposition is barred due to Opposer's acquiescence in and to Applicant's actual use of the LOCATION LAB mark for each of those services identified in Applicant's application.

### **FIFTH AFFIRMATIVE DEFENSE**

Applicant's use of its mark will not mistakenly be thought by the public to derive from the same source as Opposer's services, nor will such use be thought by the public to be a use by Opposer or with Opposer's authorization or approval.

### **SIXTH AFFIRMATIVE DEFENSE**

Applicant's mark, when used in connection with Applicant's services, is not likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of Applicant with Opposer or as to the origin sponsorship, or approval of Applicant's services by Opposer.

### **SEVENTH AFFIRMATIVE DEFENSE**

Applicant's mark in its entirety is sufficiently distinctively different from Opposer's mark to avoid confusion, deception or mistake as to the source or sponsorship or association of Applicant's services.

### **EIGHTH AFFIRMATIVE DEFENSE**

Opposer's rights in the registered LOCATIONLAB mark, if any, are limited in scope due to the weakness of that mark.

### **NINTH AFFIRMATIVE DEFENSE**

Even if the Opposer is found to be entitled to judgment with respect to Applicant's services as broadly identified in the application, Applicant is entitled to registration of its mark with a restricted identification reflecting the actual nature of its services.

### **COUNTER-CLAIMS**

Applicant hereby counterclaims to cancel Opposer's pleaded Registration No. 3,716,436 pursuant to Trademark Rule 2.106(b)(2)(I). As grounds in support of this counterclaim, Applicant alleges as follows:

#### **FIRST COUNTERCLAIM**

1. On information and belief, Opposer has made no use of the mark LOCATIONLAB in connection with any services for at least three consecutive years preceding the filing of this counterclaim for cancellation and with no intent to resume such use.
2. As a result of Opposer's failure to use the LOCATIONLAB and his intent not to resume such use, the registered LOCATIONLAB mark has become abandoned for purposes of Section 45 of the Trademark Act.

## **SECOND COUNTERCLAIM**

3. Applicant realleges paragraphs 1 through 2 as paragraph 3 of this second counterclaim.

4. On information and belief, Opposer has not used the LOCATIONLAB mark in connection with all services listed on the Registration No. 3,716,436 and Opposer does not intend to use the LOCATIONLAB mark in connection with all such services identified therein.

5. As a result, Opposer's registered mark should be restricted to only those services for which the LOCATIONLAB has been used prior to the filing of this counterclaim for cancellation to avoid any likelihood of confusion between the two marks at issue.

## **THIRD COUNTERCLAIM**

6. Applicant realleges paragraphs 1 through 5 as paragraph 6 of this third counterclaim.

7. On information and belief, Opposer lacked any bona fide intent to use the LOCATIONLAB mark in commerce at the time of registration and Opposer's subsequent purported use of the mark in connection with Applicant's services was a pretense intentionally carried out in bad faith for the fraudulent and sole purpose of securing a trademark registration by deception.

8. As a result of Opposer's fraudulent acts in connection with registration, the LOCATIONLAB mark that is the subject of Registration No. 3,716,436 was obtained fraudulently and should be cancelled pursuant to Section 14 of the Trademark Act.

## **FOURTH COUNTERCLAIM**

9. Applicant realleges paragraph 1 through 8 as paragraph 9 of this fourth counterclaim.

10. On information and belief, Opposer made material representations of fact in the Statement of Use filed with respect to the LOCATIONLAB mark that is the subject of Reg. No. 3,716,436, specifically, that he had commenced use of said mark in connection with all services listed on the application when he in fact had only used the mark for some of those services.

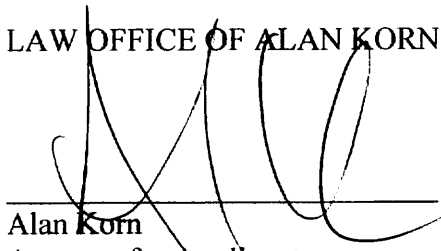
11. As a result of Opposer's failure to use the LOCATIONLAB mark in connection with all services identified in Reg. No. 3,716,436, the entire class is subject to cancellation pursuant to Section 14 of the Trademark Act.

WHEREFORE, Applicant prays that

1. The opposition proceeding be dismissed, with prejudice, and that registration for Applicant's mark issue forthwith; and
2. The counterclaim for cancellation be granted with Reg. No. 3,716,436 being ordered cancelled or otherwise restricted pursuant to 15 U.S.C. Section 1119.

Respectfully submitted,

Dated: August 17, 2011

By:   
LAW OFFICE OF ALAN KORN  
Alan Korn  
Attorney for Applicant  
WAVEMARKET, INC.

**CERTIFICATE OF ELECTRONIC FILING**

I hereby certify that the attached ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM was filed electronically with the Trademark Trial and Appeal Board on August 17, 2011.

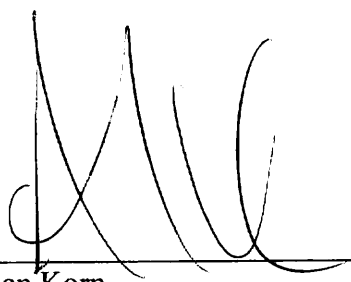


Alan Korn

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM was sent via first class United States Mail, postage prepaid, on August 17, 2011 in an envelope addressed to Opponent's counsel of record at the following address:

Gary E. Lambert, Esq.  
Brendan M. Shortell, Esq.  
Lambert & Associates  
92 State Street, Suite 200  
Boston, MA 02109



Alan Korn